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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,513	04/01/2004	E. James Arking	IK-120(US)	8227
909 7590 05/14/2007 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
			EXAMINER AKRAM, IMRAN	
			ART UNIT 1709	PAPER NUMBER
			MAIL DATE 05/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,513

Applicant(s)

ARKING ET AL.

Examiner

Imran Akram

Art Unit

1709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 8-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9-14-06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to a fractionator with a head surface configured to form a slideable seal within sample tube, a collection port disposed forward of the head surface, and a fluid passageway configured to allow fluid transport, classified in class 436, subclass 177.
 - II. Claims 8-13, drawn to a system with a head surface configured to form a slideable seal within sample tube, a collection port disposed forward of the head surface, a valve in communication with the collection port, and a valve controller configured and arranged to operate the valve based on location, classified in class 494, subclass 2.
 - III. Claims 14-16, drawn to a method for using a head surface configured to form a slideable seal within sample tube, a collection port disposed forward of the head surface, a valve in communication with the collection port, advancing the head into the sample tube until at least a portion of a sample is transported through the collection port and the fluid passageway and into at least one sample receptacle, classified in class 494, subclass 37.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process for using the product as claimed can be practiced with another materially different product, such as a soda dispenser.

3. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process for using the product as claimed can be practiced with another materially different product, such as a soda dispenser.

4. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination does not require the fluid passageway. The subcombination has separate utility such as an automated soda dispenser.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Hans-Peter G. Hoffman on 5/2/07 a provisional election was made with traverse to prosecute the invention of I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Farr (US 3,355,098).

10. Regarding claim 1, Farr discloses a fractionator having a head surface at a forward end of the head, the head being configured to form a slideable seal with the inside surface of a sample tube (see column 1, lines 61-65); a collection port disposed forward of the head surface (see column 1, lines 67-70); and a fluid passageway being configured and arranged to allow fluid transport from the sample tube to sample receptacles (see column 2, lines 10-13 and 25-26).

11. Regarding claim 5, Farr discloses a fractionator wherein the collection port is placed off-center of the head (see 16, Figure 1).

12. Claims 1, 2, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Pelecq (FR 2537092).

13. Regarding claim 1, Pelecq discloses a device having a head with head surface at the forward end of the head, the head being configured to form a slideable seal with the

inside surface of a sample tube, a collection port disposed forward of the head surface, and a fluid passageway in fluid communication with the collection port ("sealing stopper having a pouring spout for the distribution on demand of liquid held in a necked container and propelled out of the container by the intermediary of a gas...incorporated in the interior of the container, this stopper being characterized by the fact that it has a body integral with a plunger tube," page 3, lines 6-11 of translation).

14. Regarding claim 2, Pelecq discloses a head surface positioned inside the sample tube and a plenum space bounded by the head surface, the collection port, and the inner surface of the tube ("sealing stopper having a pouring spout for the distribution on demand of liquid held in a necked container and propelled out of the container by the intermediary of a gas...incorporated in the interior of the container, this stopper being characterized by the fact that it has a body integral with a plunger tube," page 3, lines 6-11 of translation).

15. Regarding claim 6, Pelecq discloses a collection port placed at the center of the head (see Figure 2).

16. Regarding claim 7, Pelecq discloses a collection port configured to isolate the head surface from a sample during collection of the sample from the sample tube (see Figure 3).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pelecq (FR 2537092).

21. Regarding claim 3, Pelecq does not disclose the ratio of the cross-sections but does disclose varying dimensions and diameters of the collection port and collection tube. It would have been obvious to one having ordinary skill in the art at the time the

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invention was to vary cross-sections and diameters to allow for varying flow rates and volumes.

22. Regarding claim 4, Pelecq discloses varying dimensions and diameters of the collection port and collection tube. It would have been obvious to one having ordinary skill in the art at the time the invention was to vary cross-sections and diameters to allow for varying flow rates and volumes.

Conclusion

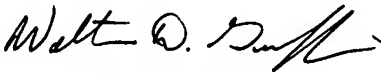
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Imran Akram whose telephone number is 571-270-3241. The examiner can normally be reached on 8-5 (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IA


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